



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,706	12/11/1998	EDWARD F. TOKAS	IR-2588(ET)	6621

7590 12/04/2001
WAYNE W RUPERT
111 LORD DRIVE
P O BOX 8012
CARY, NC 275128012

EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/209,706

Applicant(s)

TOKAS ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53, 54, 56, 57, 59-83, 93, 94, 96 and 98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53, 54, 56, 57, 59-83, 93, 94, 96 and 98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Art Unit: 1733

1. The request filed on 9-21-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/209,706 is acceptable and a CPA has been established. An action on the CPA follows.

2. In view of the papers filed 9-21-01, the inventorship in this nonprovisional application has been changed by the deletion of Mark A. Weih.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

3. Claims 53, 54, 56, 57, 59-83, 93, 94, 96 and 98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 53 as amended, it is now not clear how the "forming a coating" step relates to the "material that undergoes a metathesis reaction", it being noted that at present, the claim now reads on forming a coating that is entirely unrelated to the "material that undergoes a metathesis reaction". As this does not appear to be applicant's intent, clarification is required.

With the cancellation of claim 55, claims 72 and 74 now depend from canceled claims.

4. The declaration filed on 1-11-01 under 37 CFR 1.131, together with the change of inventorship, is sufficient to overcome the article of Weck et al. (cited by applicant) and the article of Bartz et al. (cited by applicant) references.

Art Unit: 1733

5. Claims 53, 54, 59-63, 66 and 71-82 rejected under 35 U.S.C. 102(b) as being anticipated by EP 424,833 to BF Goodrich as applied in the last office action.
6. Claims 67-71, 83, 96 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 424,833 to BF Goodrich as applied in the last office action.
7. Claims 53, 54, 56, 57, 59-83, 93, 94, 96 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO97/38036 to Ciba Specialty Chemicals taken in view of EP 424,833 as applied in the last office action.
8. Applicant's arguments filed 9-21-01 have been fully considered but they are not persuasive.

Applicant's arguments are presented principally in the statement of the substance of the interview. In particular, in light of the filing of the change of inventorship, the previously submitted declaration now is effective to obviate the rejection based upon the applied articles (as noted above). Applicant also urged that the EP reference is not forming a coating but rather is a RIM process and further would not suggest a coating thickness less than that of the substrate, this now being a required feature of claim 53. It however is still believed reasonable to term the material encapsulating the substrate (e.g. fiber mat) of the EP reference as a coating and further that the coating thickness can be deemed less than the substrate if one considers the overall mat thickness as the initial substrate thickness. In other words, when one selects a mat as a substrate, it is considered entirely reasonable to term the thickness of the substrate as the thickness of the mat and it further is submitted that one would not ordinarily term the thickness of a mat as the thickness of the individual fibers that make up the mat. It is also noted that

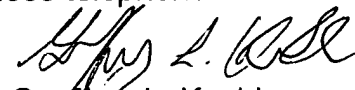
Art Unit: 1733

although proposals were discussed at the interview to better define the coating process (e.g. the actual process used to coat) and/or to define the substrate in a manner than defines over a mat as used in the reference (e.g. having a continuous surface as opposed to a porous mat that is impregnated) to help define over the EP reference, the present claims do not seem to have adopted these. It should also be noted that since the present claims do not now actually connect the "forming a coating" step to the contacting step, it is still considered that the present claims do not actually define or require that the polymerization actually occur at room temperature. Further, since EP '833 clearly contemplates contacting the substrate with the polymer material at ambient temperature - e.g. note page 10, line 4 or page 11, lines 1+, this material forming a coating, the claim 53 requirement is considered to be met even considering the coating as the "material that undergoes a metathesis reaction" - note that the claim merely defines "forming a coating" and is entirely silent on any requirements for or during post processing or polymerization of the material.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
December 2, 2001